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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,402	09/30/2003	Kiu-Hae Jung	1293.1861	3744

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EXAMINER	
AGUSTIN, PETER VINCENT	

ART UNIT	PAPER NUMBER
2627	

MAIL DATE	DELIVERY MODE
03/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/673,402	**Applicant(s)** JUNG ET AL.	
	Examiner Peter Vincent Agustin	**Art Unit** 2627	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 February 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Peter Vincent Agustin/
Primary Examiner, Art Unit 2627

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's arguments filed on February 27, 2009 have been fully considered but they are not found persuasive for the following reasons:

(a) Applicant argues (see page 2, paragraph 2) that the finality of the previous Office action is premature because the new ground of rejection was allegedly not necessitated by the amendment of November 10, 2008, but was necessitated by the improper allowance. The examiner disagrees. The allowability of the claims has been withdrawn, and therefore, any arguments directed to an "improper allowance" are moot, invalid and without merit. In response to a non-final Office action mailed on June 30, 2008, the applicant amended claims 1 & 27 (in the response filed on November 10, 2008) by adding the limitations "the information storage medium is a read-only information storage medium, and the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium". Any rejection following this amendment would have been made final. See MPEP § 706.07(a), "...second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims..." The previous rejection was made final because the new ground of rejection was necessitated by the amendment of November 10, 2008.

(b) Applicant points out (see page 3, paragraph 1) that the examiner has not relied on Shigenobu to show the feature "the additional data area is provided to make the read-only information storage medium compatible with a recordable information storage medium" that was added to claims 1 and 27, and argues that the new ground of rejection was not necessitated by the amendment including this feature. In response, it should be noted that this is not the only added limitation. Amended claim 1 also recites that "the information storage medium is a read-only information storage medium". The examiner relied upon Shigenobu for teaching this limitation. Therefore, the new rejection based on Shigenobu was necessitated by the amendment to claim 1.

(c) Applicant argues (see page 3, paragraph 2) that although the examiner relied on Shigenobu to show the feature "the information storage medium is a read-only information storage medium", the examiner was allegedly not required to rely on Shigenobu because Ho et al. (US 6,249,896) (relied on by the previous examiner in the rejections of claims 4, 7, 8, 11, 30, 31, 36 and 37 in the non-final rejection) appears to disclose this feature. In response, it should be noted that the Ho et al. reference was never used in the rejection of independent claims 1 & 27. Rather, the Ho et al. reference was used to reject the noted dependent claims, none of which recite the feature "the information storage medium is a read-only information storage medium". Furthermore, Ho et al. was not used to reject claims 1 & 27 because it does not teach all the features of claims 1 & 27, as required by 35 U.S.C. § 102. In addition, while Ho et al. might "happen to" disclose a read-only information storage medium, as pointed out by applicant, it might not have been necessarily obvious to combine this teaching with the base reference in order to formulate a rejection under 35 U.S.C. § 103. Finally, and most importantly, in rejecting the claims, the examiner is required to apply the best reference found during the search, see MPEP § 904.03. In this case, the Shigenobu reference discloses all claimed features and has a 102(b) date, qualifying it as the best reference. Therefore, the Ho et al. reference is not necessary to reject the amended claims.

(d) In response to applicant's argument in page 4 that the premature finality is an error that affects the applicant's ability to reply to the Final Office action of February 6, 2009, as noted in items (a), (b) & (c) above, the Office action was properly made final, and therefore, there is no error. Furthermore, the applicant has been given a chance to reply to the non-final Office action of June 30, 2008, and the applicant has replied with the amendment of November 10, 2008. The period of response will not be restarted. See item 1(b) above.